

REMARKS

Claims 1-13 are pending in this application. Non-elected claims 4-9 and 11-13 are withdrawn from consideration by the Examiner. By this Amendment, claims 1-13 are amended. Support for the amendments to the claims may be found, for example, in the specification at page 12, line 22 to page 13, line 8 (optical purity and ratio of poly-L-lactic acid to poly-D-lactic acid) and in the claims as originally filed. Other amendments are made to the claims to correct informalities and to better conform the claims to U.S. practice. No new matter is added.

I. Restriction under PCT Rule 13.1

Applicants confirm their provisional election of Group 1, claims 1-3 and 10, with traverse.

For at least the reasons discussed below, applicants respectfully submit that the amended claims, as set forth above, distinguish over the Mitsuru reference and, thus, share at least one corresponding special technical feature. Therefore, reconsideration and withdrawal of the restriction requirement for lack of unity of invention are respectfully requested.

II. Rejection under 35 U.S.C. §103

The Office Action rejects claims 1-3 and 10 as being unpatentable over JP 2003-073538 to Mitsuru et al. ("Mitsuru"). Applicants respectfully traverse the rejection.

Without conceding the propriety of the rejections, independent claim 1 is amended to more clearly recite various novel features of the claimed invention, with particular attention to the Examiner's comments. Specifically, claim 1 is amended to specify that:

- poly-L-lactic acid has an optical purity of at least 85 mol%;
- poly-D-lactic acid has an optical purity of at least 85 mol%; and
- the ratio of said poly-L-lactic acid to said poly-D-lactic acid in the polylactic acid composition is from 1:99 wt% to 99:1 wt%.

Despite its asserted teachings, Mitsuru does not teach such features. Moreover, even if the compound disclosed by Mitsuru was affected by any or all of the four factors asserted by the Office Action on page 5 (such that the compound contained a minute amount of unbound polylactic acid), such compound would not have rendered obvious the polylactic acid resin composition of amended claim 1.

Claim 1 would not have been rendered obvious by Mitsuru. Claims 2, 3, and 10 variously depend from claim 1 and, thus, also would not have been rendered obvious by Mitsuru. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejoinder

Applicants also respectfully request rejoinder of non-elected method claims 4 and 5 and product claims 6-9 and 11-13. Where product and process claims are presented in the same application, Applicants may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.* Because process claims 4 and 5 include all the limitations of product claim 1, process claims 4 and 5 must be rejoined with the product claims when the product claims are found allowable.

Furthermore, where restriction was required between independent or distinct products, and all claims directed to an elected invention are allowable, any restriction requirement between the elected invention and any non-elected invention that depends from or otherwise requires all the limitations of an allowable claim should be withdrawn. Claims that require all the limitations of an allowable claim should be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. *See* MPEP §821.04(a). Because claims 6-9

and 11-13 variously depend from elected product claim 1, claims 6-9 and 11-13 must be rejoined with the product claims when the product claims are found allowable.


Because the elected product claims are believed to be allowable for at least the reasons presented above, Applicants respectfully request withdrawal of the Restriction Requirement and rejoinder of claims 4-9 and 11-13.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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